

## REMARKS

The Office Action of May 16, 2006 has been received and considered. Claims 1-35 are pending. Reconsideration of the application in view of the following remarks is respectfully requested. Each of the Examiner's rejections is discussed below.

### Section 103

#### Claims 1-3, 5-19, 21-31 and 33-35

Claims 1-3, 5-19, 21-31 and 33-35 have been rejected under 35 U.S.C. § 103(a) over U.S. Patent Publication No. 2004/0002665 to Parihar ("Parihar"), in view of U.S. Patent No. 5,230,249 to Sasaki et al. ("Sasaki"). This rejection is respectfully traversed.

Parihar discloses a shoe 500 with a shoe insert 504 in the sole of the shoe. Insert 504 has a bladder 506 with a cavity having rheological material disposed therein. Coils of conductors 510 generate a magnetic field to activate the rheological material, changing its state from a liquid to a near solid to provide support in the sole for the user's foot. Conductors 510 are powered by a power supply 512, such as a battery. A switch (not shown) is used to selectively turn on and off the supply of power to the conductors 510. A processor 518 may be used to turn the power supply on and off for predetermined lengths of time and at predetermined intervals to massage the foot. Sasaki discloses a shoe having a reservoir 5c of air positioned about the heel of a user.

Applicant respectfully submits that the proposed combination of Parihar and Sasaki is improper. The Office Action asserts:

The inventions disclosed in both Sasaki and Parihar are used to solve the same problem of providing cushioning to the user's foot during impact and making sure that the **cushioning provided is similar for each impact**. Sasaki does it by keeping the pressure in the bladders the same whereas Parihar does it by using magnetic rheological fluid to keep the support/cushioning the same. (Page 4, paragraph 4; emphasis added.)

Applicant respectfully points out that this statement is not accurate. As noted in the response filed on March 1, 2006 and acknowledged in the Office Action here, Sasaki is designed to, and does, keep the pressure in the bladders the same. Parihar, on the other hand, does not

keep the support/cushioning the same and is designed not to. As expressly recited in Parihar, its support/cushioning is variable. Specifically, Parihar recites:

The magnetic field generated by the conductors 510 activates the MR fluid 508 to change its state from a liquid to a **desired degree of solidness** depending upon the strength of the generated magnetic field. For example, the insert 504 can become a **near solid** for support of the arch **or a gel** for damping of forces on the heel due to running. (Page 7, paragraph 0118; emphasis added.)

Thus, contrary to the assertion in the Office Action, the support/cushioning of Parihar is designed to be variable. Sasaki, on the other hand, has as an express object providing air pressure at a constant “proper level.” (Col. 1, lines 55-58.)

Sasaki is expressly designed to have a very specific pressure, which is to remain constant during use. If the air pressure changes, Sasaki teaches that it can quickly be restored to the desired constant level. Thus, one skilled in the art reading Sasaki would be taught away from a reservoir with varying pressure.

Accordingly, one skilled in the art would not combine the teachings of Sasaki and Parihar to replace the bladder of Parihar with the reservoir of Sasaki since Sasaki teaches away from such a combination. Sasaki teaches that the user inflates the reservoir to a desired pressure, and the reservoir is intended to remain at that pressure. Sasaki is not intended to be used with a reservoir that has a varying pressure, like the bladder of Parihar, and Sasaki teaches away from a variable pressure.

Consequently, the rejection is improper and should be withdrawn.

#### **Claims 4, 20 and 32**

Claims 4, 20 and 32 have been rejected under 35 U.S.C. § 103(a) over Parihar and Sasaki in view of U.S. Patent No. 5,813,142 to Demon (“Demon”). Demon is cited as disclosing an article of footwear that transforms from one state to another upon detection of a force from a user’s foot. This rejection is respectfully traversed.

Demon fails to overcome the deficiencies of Parihar and Sasaki noted above. That is, Demon fails to disclose or make obvious at least one reservoir of magneto-rheological fluid in an

upper of an article of footwear, as required by independent claim 1; a reservoir of magneto-rheological fluid in a sidewall of an upper, as required by independent claim 17; or a first reservoir of magneto-rheological fluid formed in a lateral sidewall of an upper and a second reservoir of magneto-rheological fluid formed in a medial sidewall of an upper, as required by independent claim 29.

Accordingly, the rejection is improper and should be withdrawn.

**Conclusion**

Pending claims 1-35 are believed to be in form for allowance, and an indication to that effect is respectfully requested at this time. Please apply any charges or credits to Deposit Account No. 19-0733.

Respectfully submitted,

Dated: August 16, 2006

/Gregory J. Cohan/  
Gregory J. Cohan, Reg. No. 40,959  
BANNER & WITCOFF, LTD.  
28 State Street, 28th Floor  
Boston, MA 02109  
(617) 720-9600